

REMARKS

This Response is submitted in response to the Office Action dated August 9, 2006. Claims 1 to 66 are pending in the application. Claims 14 to 25 and 33 to 42 have been withdrawn from consideration. Applicants have canceled Claims 14 to 25 and 33 to 42 without prejudice or disclaimer. Applicants have also amended Claims 1, 26, 43 to 45, 55, 61 and 64. The amendments to the claims do not introduce new subject matter. Applicants have further submitted herewith a Supplemental Information Disclosure Statement. The Commissioner is hereby authorized to charge deposit account 02-1818 for any fees which are due and owing.

The Office Action objected to Claims 44 and 45. Applicants have made appropriate correction and respectfully submit that the objection has been overcome.

The Office Action rejected Claims 1 to 13, 26 to 32 and 43 to 66 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,264,198 to *Stamper* ("Stamper") in view of U.S. Application No. 2004/0201169 to *Schaefer* ("Schaefer"). The Office Action further relies on the general knowledge in the art to contend that the claimed invention is a matter of design choice and would have been obvious to one of skill in the art at the time of the invention.

Claims 1, 26, 43, 55, 61 and 64 have each been amended to clarify the claimed invention. In particular, Claim 1 has been amended to provide among other elements, a display device operable with a processor for each play of a game, to provide an outcome to a player for the play of the game based on a designated combination obtained by the player and selected puzzle pieces not part of the designated combination, but matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces for the play of the game.

Claim 43 has been amended to provide, among other elements, a processor programmed for each play of a game to provide an outcome to a player for said play of the game based on a designated combination obtained by the player and the picked puzzle pieces not part of said designated combination, but matingly connected to at

least one of the puzzle pieces in the designated combination of the puzzle pieces in the play of the game.

Claims 26, 55, 61 and 64 have been amended to provide a method including, among other elements, for each of a game, providing an outcome to a player based on a designated combination of puzzle pieces obtained by the player and any selected puzzle pieces not part of said designated combination, but matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces.

Stamper alone, or in combination with *Schaefer*, does not teach or suggest providing an outcome to a player for each play of a game based on a designated combination obtained by the player and based on selected puzzle pieces not part of the designated combination, but matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces as in the claimed invention.

Stamper discloses a moving video image jigsaw puzzle game. The game includes displaying puzzle pieces depicting a portion of a moving video image. The puzzle pieces are scattered across the display. (*Stamper*, Abstract.) Instead of only including the puzzle pieces necessary to solve the puzzle, *Stamper* discloses providing additional puzzle pieces that are unnecessary for solving the puzzle to enhance the difficulty of the game. (*Stamper*, column 6, lines 12-15.) The player in *Stamper* selects the puzzle pieces by clicking on the puzzle pieces using an input device. The player uses the input device to rotate and "drag" the puzzle pieces from one location on the display to another to reposition the puzzle pieces. Once all of the puzzle pieces have been correctly repositioned to recreate the original moving video image in *Stamper*, the puzzle is complete. (*Stamper*, column 5, lines 14-26.) In *Stamper*, a player of a video game other than the puzzle game may be required to solve the moving video image puzzle in order to continue playing an associated video game or to reach a certain level in the associated video game. The moving video image puzzle may be a subroutine, such that once a puzzle is solved, the player is returned to the other video game. (*Stamper*, column 8, lines 43-54.)

Stamper does not disclose providing an outcome to a player for each play of a game based on a designated combination obtained by a player and based on selected puzzle pieces not part of the designated combination, but matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces as in the claimed invention. *Stamper* only provides an outcome to the player if the player completes the puzzle. Therefore, even if the pieces of a completed puzzle can be interpreted as a designated combination of puzzle pieces, as suggested in the Office Action, Applicants respectfully submit that advancement to another game or level of a game is based only on the pieces of the completed puzzle. An advancement to another game or level of a game is not based on selected puzzle pieces which are not part of the completed puzzle. Furthermore, the Office Action acknowledges at page 3, that *Stamper* does not disclose "allowing the player to pick selections only until the player obtains a designated combination of the puzzle pieces and awarding the player based on the designated combination and the selected puzzle pieces matingly connected to the puzzle pieces in the designated combination of the puzzle pieces." The Office Action relies on *Schaefer* to cure these deficiencies of *Stamper*.

Schaefer also does not teach or suggest providing an outcome to a player for each play of a game based on a designated combination obtained by a player and based on selected puzzle pieces not part of the designated combination, but matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces as in the claimed invention. *Schaefer* discloses a lottery ticket with multiple game regions or puzzles. (*Schaefer*, Abstract.) For each game region, the lottery ticket has a first play area that contains first jigsaw-type puzzle pieces and a second play area which contains second jigsaw-type puzzle pieces. A prize is won if a minimum number of first jigsaw type puzzle pieces match second jigsaw type puzzle pieces for winning a prize for that particular game region. If less than the number of puzzle pieces are matched, then the lottery ticket is not a winner for that game region. The player repeats the procedure described above for the remaining game regions to determine if a prize has been won. The player may win a prize if one played game region meets the minimum matching requirements, or a larger or multiple prizes may be

won if the minimum matching requirement is met in two or more game regions. Furthermore, one or more of the game regions may be designated as a bonus game region in which a different prize may be won than the prizes associated with the other game regions. (*Schaefer*, paragraph [0024].)

Even if the matching puzzle pieces in *Schaefer* can be interpreted to be a designated combination, *Schaefer* only discloses providing an award for puzzle pieces in one play area that match puzzle pieces in another play area as described above. An award in *Schaefer* is not based on non-matching puzzle pieces. Therefore, even if *Schaefer* can be properly combined with *Stamper*, neither *Stamper* nor *Schaefer* alone, or in combination teach or suggest providing an outcome to a player for a play of a game based on a designated combination obtained by a player and based on selected puzzle pieces not part of the designated combination, but matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces as in the claimed invention.

Moreover, basing an outcome on a designated combination obtained by a player and on selected puzzle pieces which are not part of the designated combination, but which are matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces is not simply a design choice of providing appropriate payouts based on the level of progress made toward predetermined image combinations as suggested in the Office Action. For example, a first player completes eleven puzzle pieces toward a predetermined image combination in a game, but none of the pieces are part of a designated combination of puzzle pieces. A second player completes ten puzzle pieces toward a predetermined image combination in a game and, for example, four puzzle pieces are part of a designated combination obtained by a player, and six selected puzzle pieces are not part of the designated combination, but are matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces. In a game where the outcome is based on the level of progress made toward predetermined image combination, the first player would receive a more favorable payout for completing more of the puzzle than the second player. In contrast, if the outcome is based on a designated combination obtained by a

player and based on selected puzzle pieces which are not part of the designated combination, but which are matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces as in the claimed invention, the second player would receive the more favorable outcome. Therefore, basing an outcome on a designated combination obtained by a player and on selected puzzle pieces which are not part of the designated combination, but which are matingly connected to at least one of the puzzle pieces in the designated combination of the puzzle pieces is not simply a design choice which would have been obvious to a person of ordinary skill in the art at the time of the invention.

Therefore, neither the combination of *Stamper* and *Schaefer*, nor the general knowledge in the art at the time of the invention would have motivated one of skill in the art to arrive at the claimed invention. Accordingly, Applicants respectfully submit that the rejection has been overcome and that Claims 1, 26, 43, 55, 61 and 64, and the claims which depend therefrom, are in condition for allowance.

An earnest endeavor has been made to place this application in condition for allowance and such allowance is courteously solicited. If the Examiner has any questions related to this Response, Applicants respectfully submit that the Examiner contact the undersigned.

Respectfully submitted,

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